REMARKS

In response to an Office Action dated July 18, 2001 an amendment was filed on October 18, 2001 and a supplemental amendment was filed on January 22, 2002 to place the application in condition for allowance.

On January 29, 2002 the Examiner issued a Notice of Allowance which included an Examiner's amendment. In the Examiner's amendment claim 1, lines 6 and 7 and claim 15, lines 6 and 7 were amended to remove the word "preferably". In addition claim 1, line 3 and claim 15, line 3 were amended to insert the language ", and countersink". It is submitted that these amendments were made to the claims for purposes of 35 U.S.C. §112, second paragraph and not for purposes of patentability or to define around cited prior art. However, as discussed in greater detail below, this amendment resulted in unduly narrowing the claims which necessitated the present amendment.

As discussed in the specification and in the "Remarks" section of the amendment filed on October 18, 2001 (See p. 10 of the amendment) the present invention relates to roll that includes a plurality of bores in the roll mantle and a plurality of receases in the surface of the roll to interconnect each bore with at least another one bore adjacent to said bore. It is noted as emphasized in the specification that the specific type of bore may vary. For example the bore may travel through the roll (i.e. be a hole as stated in the specification) or it may be a blind drilled bore in the surface of the mantle. Further the bore may optionally further include a countersink. In this regard it is noted that claim 7 as allowed did not require a countersink.

In view of the above it is submitted that the amendments to the claims made in the Examiner's amendment for purposes of 35 U.S.C. §112, second paragraph inadvertently overly narrowed the claims by requiring structure (i.e. countersinks) in the claim that is not required for patentability purposes. In this regard the Examiner's attention is directed to claim 7 as allowed which did not require the countersink language and also to the Examiner's statement of reasons for allowance which reed as follows:

The primary reasons for allowance is that the cited prior art does not show a roll for dewatering a web in a paper machine comprising: a mantle having a phrality of bores and recesses through the outer surface of the mantle, so that each bore is connected with each bore adjacent to it in the form of a groove or recess.

In view of the above claim 7 has been amended herein so that it clearly covers all the embodiments of the invention. Specifically the term bore has been replaced with opening extending at least partially into an outer surface of the roll mantle. This language makes it clear that the invention is not limited to a bore that extends entirely through the roll mantle but also includes bores or the like that extend only partially into the surface of the roll mantle. The pending dependent claims have been amended merely to reflect the change in terminology from bore to opening.

New claims 16-20 have been added to clearly cover the specific embodiments of the invention. Claims 1-5 and 15 have been canceled since the subject matter of these claims is now covered by the claims as amended herein and new claims 16-20.

The present amendment is required so that the allowed claims clearly cover all the patentable embodiments of the invention. The present amendment does not require any additional search or examination since the amendments to the claims herein do not broaden the claims beyond the subject matter that the Examiner has already deemed allowable and are consistent with the Examiner's reasons for allowance. The claims as amended herein are patentable since the cited prior art does not show a roll for dewatering a web in a paper machine comprising: a mantle having a plurality of openings and recesses in the outer surface of the mantle, so that each opening is connected with each opening adjacent to it. The present amendment was not presented earlier because the present amendment was necessitated by the Examiner's amendments to the claims made in the Notice of Allowance which were made merely for purposes of 35 U.S.C. §112, second paragraph but inadvertently resulted in overly narrowing the claims.

If any changes to the specification and/or claims are deemed necessary to place the application in condition for allowance, the Examiner is respectfully requested to contact the undersigned to discuss the same.

If any fee is required for entry of this amendment the Commissioner is hereby authorized to charge any requisite fee to Deposit Account No. 50-0518 in the name of Steinberg & Raskin, P.C.

Respectfully submitted,

STEINBERG & RASKIN, P.C.

Dated: March 20, 2002

Paul J. Higgins Reg. No. 44,152

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ATTENTION: Mark Halpern

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